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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/897,583	06/29/2001	Thomas A. Szyperski	19226/2051 (R-5655)	1224

7590

09/30/2003

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EXAMINER

GAKH, YELENA G

ART UNIT

PAPER NUMBER

1743

DATE MAILED: 09/30/2003

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Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/897,583

Applicant(s)

SZYPERSKI, THOMAS A.

Examiner

Yelena G. Gakh, Ph.D.

Art Unit

1743

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 29 June 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-130 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_\_ is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) 1-130 are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

**DETAILED ACTION*****Election/Restrictions***

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
  - I. Claims 1-12, drawn to a method of conducting reduced 3D HA,CA,(CO),N,NH NMR experiment, classified in class 324, subclass 307.
  - II. Claims 13-19, drawn to a method of conducting reduced 3D H,C,(C-TOCSY-CO),N,NH NMR experiment, classified in class 324, subclass 307.
  - III. Claims 20-25, drawn to a method of conducting reduced 3D H <sup>$\alpha/\beta$</sup> ,C <sup>$\alpha/\beta$</sup> ,CO,HA NMR experiment, in class 324, subclass 307.
  - IV. Claims 26-31, drawn to a method of conducting reduced 3D H <sup>$\alpha/\beta$</sup> ,C <sup>$\alpha/\beta$</sup> ,N,NH NMR experiment, classified in class 324, subclass 307.
  - V. Claims 32-38, drawn to a method of conducting reduced 3D H,C,C,H-COSY NMR experiment, classified in class 324, subclass 307.
  - VI. Claims 38-43, drawn to a method of conducting reduced 3D H,C,C,H-TOCSY NMR experiment, classified in class 324, subclass 307.
  - VII. Claims 44-49, drawn to a method of conducting reduced 2D HB,CB,(CG,CD),ND NMR experiment, classified in class 324, subclass 307.
  - VIII. Claims 50-52, drawn to a method of conducting reduced 2D H,C,H-COSY NMR experiment, classified in class 324, subclass 307.
  - IX. Claims 53-63, drawn to a method for sequentially assigning chemical shifts of  $\alpha$ -proton and  $\alpha$ -carbon and polypeptide backbone amine nitrogen and proton, classified in class 436, subclass 173.
  - X. Claims 64-81, drawn to a method for sequentially assigning chemical shifts of  $\alpha$ - and  $\beta$ -protons,  $\alpha$ - and  $\beta$ -carbons and polypeptide backbone amine nitrogen and proton, classified in class 436, subclass 173.
  - XI. Claims 82-90, drawn to a method for sequentially assigning chemical shifts of aliphatic protons and carbons, classified in class 436, subclass 173.

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XII. Claims 91-130, drawn to a method for obtaining assignment of chemical shifts of protons, carbon and nitrogen atoms of a protein molecule, classified in class 436, subclass 86.

The inventions are distinct, each from the other because of the following reasons:

Inventions I-XIV are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions I-VIII have different modes of operation and different effects, since they employ different pulse sequences which have different effects on atoms involved in different connectivities; inventions I-VIII and IX-XII have different functions, as the first eight inventions are drawn to the method of conducting different pulse sequences, while other four inventions are drawn to the methods of assigning chemical shifts; inventions IX-XII have different modes of operation, different functions and different effects, since they utilize different pulse sequences which lead to assigning different atoms of different fragments. All twelve groups of inventions comprise different method steps.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter, restriction for examination purposes as indicated is proper.

2. A telephone call was made to Alice Choi on 09/26/03 to request an oral election to the above restriction requirement, but did not result in an election being made.

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Yelena G. Gakh, Ph.D. whose telephone number is (703) 306-5906. The examiner can normally be reached on 9:30 am - 6:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jill A. Warden can be reached on (703) 308-4037. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.

Yelena G. Gakh

9/28/03

A handwritten signature in black ink, appearing to read "Yelena Gakh", written in a cursive style.